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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* FRANK LAYMANN and DIETER ROLLER

Appeal 2008-1050
Application 10/042,799
Technology Center 2100

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Decided:

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*Before*: JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

## I. STATEMENT OF CASE

Appellants appeal the Examiner's final rejection of claims 1-14 under 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b).

## A. INVENTION

According to Appellants, the invention provides a method of operating a computer system such that in all cases of a loss of connection between any of the application servers and the database, all requests to be processed by the failing application server are performed without an undue delay and without requiring a lot of additional procedures (Spec. 2, ll. 18-23).

## B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. Method of operating a computer system, wherein said computer system comprises at least one application client (15), at least two application servers (20, 21) which are suitable to process requests of the application clients (15), and a database (26) accessible by the two application servers (20, 21), and wherein said method comprises the steps of:

recognising that the first one of the two application servers (20, 21) fails to access the database (26),

sending a request of the application client (15) for the first application server (21) from the first application server (21) to the second application server (20) while the first one of the two application servers (20, 21) fails to access the database,

processing the request by the second application server (20), and

sending a response to the request from the second application server (20) to the first application server (21).

## C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

| | | |
|---|---|---|
| Holmberg | US 6,247,141 B1 | Jun. 12, 2001 |
| Helmer | US 6,411,991 B1 | Jun. 25, 2002 |
| Rizvi | US 6,490,610 B1 | Dec. 3, 2002 |

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) over the teachings of Holmberg, Rizvi and Helmer.

## II. ISSUES

The issue is whether Appellants have shown that the Examiner erred in finding that claims 1-14 are unpatentable under 35 U.S.C. § 103(a), and in particular, that Helmer teaches "sending a request of the application client for the first application server from the first application server to the second application server while the first one of the two application servers fails to access the database" (Claim 1).

## III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

*Helmer*

1. Helmer is directed to geographic data replication, wherein temporary data for a remote server is replicated to a local server. If a server fails, such as the local server, the remote server begins processing user requests based on the temporary data it received from the local server (col. 2, ll. 2-16). That is, if the local server fails, the user request is

routed to the remote server, wherein the remote server processes the request with the benefit of the previously generated temporary data (col. 2, ll. 52-55). Any routing technique may be used to route the user requests processed by the failed data center to the other data center (col. 7, ll. 35-40; fig. 1).

## PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

The Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. *KSR,* 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court noted that "[c]ommon sense teaches . . . that

familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR*, 127 S. Ct. at 1742. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.*

The Federal Circuit recently recognized that "[a]n obviousness [determination] is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1740-41).

In the absence of separate arguments with respect to claims subject to the same rejection, those claims stand or fall with the claim for which an argument was made. *See In re Young,* 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

## V. ANALYSIS

Appellants do not provide separate arguments with respect to the rejection of claims 1-14. Therefore, we select independent claim 1 as being representative of the cited claims. 37 C.F.R. § 41.37(c)(1)(vii).

*All Claimed Elements are Taught*

Appellants argue that the cited references fail to disclose the cited limitations of the claims on appeal, and in particular, "[d]espite the Examiner asserting that Helmer teaches that a *failed* server routes requests to a remote server, upon reviewing both the above-cited passages and the remaining passages within Helmer, Appellants are unable to determine specifically where this teaching is found with Helmer" (App. Br. 7). In the Reply Brief, though Appellants admit that "the user request is routed to the remote server," Appellants add the argument that "Helmer is silent as to the entity performing the routing" (Reply Br. 5). Furthermore, though Appellants also admit that "Appellants do not question that there are many teachings, in a multitude of references, of operations that occur while a application server fails to access a database," Appellants add that "certain operations are taught as occurring while an application server fails to access a database may be coincidental" and thus the Examiner "failed to put forth a realistic, common sense rationale" for the remote server receiving the data while the server has failed (Reply Br. 4).

Accordingly, the issue is whether Helmer discloses "sending a request of the application client for the first application server from the first application server to the second application server while the first one of the two application servers fails to access the database" (Claim 1).

We agree with the Examiner's finding that Helmer discloses such claimed limitation beginning at page 5 of the Answer, and the Examiner's corresponding responsive arguments beginning at page 7 of the Answer.

Helmer discloses that, when a local server fails, the user requests **processed by the failed data center** are **routed to the remote server (using any routing technique)**, and the remote server begins processing user requests based on the temporary data it **received from the local server** (FF 1). The Examiner finds that "Helmer clearly teaches 'a failed server routing requests to a remote server'" (Ans. 8). We generally agree.

We find that Helmer clearly teaches that the remote server receives data (such as temporary data) from the local server, and that the user requests that are processed by the failed local server are routed to the remote server (FF 1). Thus, we find that Helmer teaches, or at the least, strongly suggests, that the request is sent from the failed local server (that processed the request) to the remote server. In fact, an artisan would have understood that it would have been obvious to select the local server as the server from which to send the request that it processed, to the remote server, because the remote server regularly receives data from the local server, and the artisan is a person of ordinary creativity, not an automaton. *See KSR*, 127 S. Ct. at 1742. We find that such sending of the request from the local server is merely simply incorporating the local server to perform the same function it had been known to perform, yielding merely expected results, and thus, such incorporation is obvious. *See KSR,* 127 S. Ct. at 1740.

As to the claimed "while the first one of the two application servers fails to access the database," we disagree with Appellants' argument that the Examiner "failed to put forth a realistic, common sense rationale" (Reply Br. 4).

Helmer discloses that, when the local server fails, the user request is routed to the remote server (FF 1). In fact, as Appellants admit, "there are many teachings, in a multitude of references, of operations that occur while an application server fails to access a database" (Reply Br. 4). We find that such routing of the user request when the local server fails of Helmer occurs in various situations ***including*** *while* the local server fails to access the database. In fact, an artisan would have understood that the routing occurs while the local server fails since the purpose of the Helmer invention is for the remote server to process the data when the local server fails. Contrary to Appellants' argument that the Examiner "failed to put forth a realistic, common sense rationale," we find that such routing of the request while the server fails is merely the server performing the same function that it has been known to perform, yielding expected results. Thus, we find that the subject matter as a whole would have been obvious to the artisan.

*It Would Have Been Obvious to Combine the References*

The Appellants argue that "the Examiner has failed to establish a proper motivation to modify the combination of Holmberg and Rizvi in view of Helmer" and that "the Examiner has failed to establish a realistic nexus between the proposed modification and the asserted benefit" (App. Br. 7). However, Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *See KSR,* 127 S. Ct. at 1734. Obviousness

determination is not the result of a rigid formula disassociated from the consideration of the facts of a case, and the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not. *See Leapfrog*, 485 F.3d at 1161. The test for obviousness is rather what the combined teachings of the references would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991).

We find that a person of ordinary skill will be able to fit the teachings of Holmberg, Rizvi, and Helmer together like pieces of a puzzle since the person of ordinary skill is also a person of ordinary creativity, not an automaton. *See KSR*, 127 S. Ct. at 1742. We thus agree with the Examiner that one of ordinary skill in the art at the time of the invention would have found it obvious to combine the teachings of Holmberg, Rizvi, and Helmer.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in finding that Helmer teaches "sending a request of the application client for the first application server from the first application server to the second application server while the first one of the two application servers fails to access the database" (Claim 1). We then conclude that the Examiner did not err in rejecting claim 1 and claims 2-14 falling with claim 1, under 35 U.S.C. § 103(a).

## CONCLUSION OF LAW

(1) Appellants have not shown that the Examiner erred in finding claims 1-14 unpatentable under 35 U.S.C. § 103(a) over the teachings of Holmberg, Rizvi, and Helmer.

(2) Claims 1-14 are not patentable.

## DECISION

The Examiner's rejection of claims 1-14 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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